

ESTTA Tracking number: **ESTTA687285**

Filing date: **08/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Box, Inc.
Granted to Date of previous extension	08/01/2015
Address	4440 El Camino Real Los Altos, CA 94022 UNITED STATES
Attorney information	Nigamnarayan Acharya Seyfarth Shaw LLP 1075 peachtree street ne, 2500 Atlanta, GA 30309 UNITED STATES nacharya@seyfarth.com, TMAtlanta@seyfarth.com

### Applicant Information

Application No	79158548	Publication date	06/02/2015
Opposition Filing Date	08/03/2015	Opposition Period Ends	08/01/2015
International Registration No.	1231394	International Registration Date	09/16/2014
Applicant	KOOOIK INC 100 Pine Street UNITED STATES		


### Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Recorded computer software and downloadable computer software programs for use in storing and sharing electronic files
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Transmission of computer files, particularly, electronic exchange and transmission services of digital files among Internet users
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Design, development and implementation of computer software

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3429191	Application Date	10/05/2006
Registration Date	05/20/2008	Foreign Priority Date	NONE
Word Mark	BOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/01 Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information		


U.S. Registration No.	3722965	Application Date	12/04/2007
Registration Date	12/08/2009	Foreign Priority Date	NONE
Word Mark	BOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2009/06/01 First Use In Commerce: 2009/06/01 advertising the goods and services of others via the Internet		


U.S. Registration No.	3612423	Application Date	12/04/2007
Registration Date	04/28/2009	Foreign Priority Date	NONE
Word Mark	BOX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/01 On-line journals, namely, blogs discussing technology and business

U.S. Registration No.	4656568	Application Date	11/07/2011
Registration Date	12/16/2014	Foreign Priority Date	NONE
Word Mark	BOX		
Design Mark			
Description of Mark	The mark consists of the term "box" in stylized blue on a square background containing a white cloud with a bit of bluesky showing above the white cloud. The color gray appears as shadowing for the bottom edge of the square.		
Goods/Services	Class 009. First use: First Use: 2011/10/10 First Use In Commerce: 2011/10/10 Computer software for online managementof business content in the field of cloud computing services; computer software, namely, downloadable programs and mobile device software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer software for cloud content management; computer software for providing access to, providing information to, and obtaining information from computer networks for cloudcontent management; computer software for synchronizing local computer files, folders, data and information with a cloud storage platform;		

	computer software for synchronizing computer files, folders, data and information within a collaborative work environment; computer software for use in data storage and file synchronization Class 039. First use: First Use: 2011/10/10 First Use In Commerce: 2011/10/10 Electronic storage of remote computer data
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U.S. Registration No.	4160656	Application Date	10/18/2011
Registration Date	06/19/2012	Foreign Priority Date	NONE
Word Mark	BOX SYNC		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2010/06/15 First Use In Commerce: 2010/06/15 Computer software for synchronizing local computer files, folders, data and information with a cloud storage platform; computer software for synchronizing computer files, folders, data and information within a collaborative work environment; computer software for use in data storage and file synchronization</p> <p>Class 042. First use: First Use: 2010/06/15 First Use In Commerce: 2010/06/15 Computer services, namely, providing temporary use of on-line non-downloadable computer software for synchronizing local computer files, folders, data and information with a cloud storage platform; computer services, namely, providing temporary use of on-line non-downloadable computer software for synchronizing computer files, folders, data and information within a collaborative work environment</p>		

U.S. Registration No.	4668273	Application Date	04/29/2013
Registration Date	01/06/2015	Foreign Priority Date	NONE
Word Mark	BOX NOTES		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2013/09/30 First Use In Commerce: 2013/09/30 Computer software for capturing, organizing, searching, storing, synchronizing, recognizing, sharing, editing and transmitting any number of typed or imaged notes within a collaborative work environment</p> <p>Class 042. First use: First Use: 2013/09/30 First Use In Commerce: 2013/09/30 Computer services, namely, providing temporary use of on-line non-downloadable computer software for capturing, organizing, searching, storing, synchronizing, recognizing, sharing, editing and transmitting any number of typed or imaged notes within a collaborative work environment</p>

Attachments	<p>77015157#TMSN.png( bytes )  77343975#TMSN.png( bytes )  77976378#TMSN.png( bytes )  85466608#TMSN.png( bytes )  85450245#TMSN.png( bytes )  85979605#TMSN.png( bytes )  BoxlessOp080315.pdf(1290685 bytes )</p>
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nigamnarayan Acharya/
Name	Nigamnarayan Acharya
Date	08/03/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BOX, INC.,

Opposer,

v.

KOOOIK INC.,

Applicant.

Opposition No. N/A

Mark: BOXLESS & design  
Application No. 79/158,548  
Filing Date: January 8, 2015

**NOTICE OF OPPOSITION**

Box, Inc. ("Box" or "Opposer") believes that it will be damaged by the issuance of a registration for the mark BOXLESS & design (the "Opposed Mark") as applied for in Application Serial No. 79/158,548 on January 8, 2015 and having an international filing date of September 16, 2014 ("Application"), by Koooik, Inc. ("Applicant"), and hereby opposes registration of the same.

As grounds for opposition, Opposer alleges that:

1. Box has timely filed this Opposition.

**THE PARTIES**

2. Opposer is a Delaware corporation having its principal place of business at 4440 El Camino Real, Los Altos, CA 94022.

3. Upon information and belief, Applicant is a Delaware corporation having an address of 100 Pine Street, 1250 Suite, San Francisco, California.

## **FACTUAL BACKGROUND**

4. Box is a leading provider of on-line content storage, archival, management and cloud collaboration services. Box provides a cloud-based enterprise content collaboration platform that enables organizations of various sizes to access, store, share, and manage their content/information. Box's solutions include FTP alternative to keep content organized, share files, and manage content access; document management; an executive boardroom for simplified meeting management, security and control, and secure mobile access; project management; a virtual data room; marketing asset management; a sales portal; secure enterprise mobility; and business applications for enterprise-readiness.

5. Box serves advertising, construction, consumer packaged goods, education, energy, financial services and insurance, government, healthcare and life sciences, high tech, legal, manufacturing, media and entertainment, nonprofits, and retail industries. Through its website box.com and its applications, Box allows users—including individuals, small businesses and large businesses to remotely store, archive, access, and share documents, files, and collaborate in the "cloud."

6. Since its inception in 2005, Box has provided a cloud content management solution that enables users to remotely and securely store, access, and share content online. Through Box's online workspace, customers can upload, organize, view and work on a variety of documents, files and media. To track and search content, Box offers users real-time updates through an activity feed and a full-text search engine to search within files.

7. Box offers users a variety of ways to access their content through Box's website, mobile applications, or through partner applications such as iPhone Apps, Google Apps, NetSuite and Salesforce. Box also offers a feature known as "Box Sync," which allows users to synchronize their computer desktop files directly with their Box content.

8. By virtue of its efforts, and the expenditure of considerable sums for advertising and other forms of promotion, and by virtue of the consistent excellence of its products and services, Opposer has earned an extremely valuable reputation for the BOX Marks.

9. Box has sold tens of millions of dollars' worth of goods and services under the BOX mark, the BOX & design mark, the BOX SYNC mark, the BOX NOTE Mark, and other BOX-formative marks (individually and collectively, the "BOX Marks")

10. Box's rights in the BOX Marks and variations thereof are evidenced by its ownership of the following registrations: Registration No. 3,429,191 for the word mark BOX in class 42, filed October 5, 2006; Registration No. 3,722,965 for the word mark BOX in class 35, filed December 4, 2007; Registration No. 3,612,423 for the word mark BOX in class 41, filed December 4, 2007; Registration No. 4,656,568 for the mark BOX & design in classes 9 and 39, filed November 7, 2011, Registration No. 4,160,656 for the mark BOX SYNC in classes 9 and 42, filed October 18, 2011; and Registration No. 4,668,273 for the mark BOX NOTES in classes 9 and 42, filed April 29, 2013 (collectively, "Opposer's Registrations"). True and correct copies of the



USPTO TESS and TSDR printouts for Opposer's Registrations are attached hereto as Exhibit A. These registrations are in full force and effect.

11. Box's federal trademark registrations for the Box Marks serve as prima facie evidence of: (a) the validity of the registered marks; (b) Box's ownership of the marks; and (c) Box's exclusive right to use the BOX Marks in commerce.

12. The well-known use of the BOX Marks has been continuous, exclusive and uninterrupted since the initial first use dates.

13. Opposer's BOX Marks have been registered for more than five (5) years on the Principal Register.

14. Opposer has further developed common-law rights in the BOX Marks in addition to rights extended by federal registrations thereof.

**Applicant and Applicant's Mark**

15. The current owner is listed in the Application as Koooik, Inc.

16. Applicant filed the Application pursuant to Section 66(a) of the Lanham Act.

17. Upon information and belief, Applicant selected a mark to trade-upon and use the goodwill associated with the BOX marks. Applicant has identified itself as a "BOX" solution in its advertising and webpages.

18. As evidenced by the June 2, 2015 publication, Applicant seeks to register the Opposed Mark as a trademark for goods in class 9 and services in classes 38 and 42.

19. Applicant seek to register the Opposed Mark in class 9 with goods identified as "Recorded computer software and downloadable computer software programs for use in storing and sharing electronic files."

20. Applicant seek to register the Opposed Mark in class 38 with services identified as "Transmission of computer files, particularly, electronic exchange and transmission services of digital files among Internet users."

21. Applicant seek to register the Opposed Mark in class 42 with services identified as "Design, development and implementation of computer software."

**CLAIM FOR RELIEF**  
**Count One**  
**Likelihood of Confusion, 15 USC 1052(d)**

22. Box repeats and realleges the allegations in preceding paragraphs 1 through 21 as if fully set forth herein.

23. Opposer's filing dates and first use dates in Opposer's Registrations predate Applicant's use of the Opposed Mark in the United States. Box has used in commerce, registered, and/or applied to register its BOX Marks before Applicant's January 8, 2014 filing date of the Application, the September 14, 2014 international filing date and/or any first-use date that may be alleged by Applicant.

24. The Opposed Mark so resembles the Box's prior used, filed, and/or registered Box Marks, as to be likely, when used on or in connection with the services identified in the Application, to cause confusion, to cause mistake, or to deceive under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it will be damaged by the registration of the mark shown in Application its opposition be sustained and that the registration sought by Applicant be refused.

A filing fee has been submitted electronically. Please charge any deficiency or credit any overpayment related to this Opposition to Deposit Account No. 50-5265. The required \$300.00 opposition fee is being electronically processed in connection with this Notice of Opposition.

Dated: August 3, 2015

Respectfully Submitted,

/NIGAMNARAYAN ACHARYA/

Nigamnarayan Acharya  
Joseph V. Myers III  
**Attorneys for Box, Inc.**

SEYFARTH SHAW LLP  
1075 Peachtree Street, N.E., Suite 2500  
Atlanta, Georgia 30309  
(404) 885-1500  
[jmyers@seyfarth.com](mailto:jmyers@seyfarth.com)  
[nacharya@seyfarth.com](mailto:nacharya@seyfarth.com)

### **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing  
NOTICE OF OPPOSITION has been served upon the following counsel of record via  
First Class Mail, postage prepaid, on this 3rd day of August 2015:

Donald C. Lucas  
Lucas and Mercanti LLP  
21st Floor 30 Broad Street  
New York, NY 10004

By: /Nigamnarayan Acharya/

# Exhibit A



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# BOX

**Word Mark  
Goods and  
Services**

BOX

IC 042. US 100 101. G &amp; S: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information. FIRST USE: 20070101. FIRST USE IN COMMERCE: 20070101

**Standard  
Characters  
Claimed****Mark Drawing  
Code**

(4) STANDARD CHARACTER MARK

**Serial Number**

77015157

**Filing Date**

October 5, 2006

**Current Basis**

1A

**Original Filing  
Basis**

1B

**Published for  
Opposition**

March 4, 2008

**Registration  
Number**

3429191

**Registration  
Date**

May 20, 2008

**Owner**

(REGISTRANT) Box.net, Inc. CORPORATION WASHINGTON 1895 El Camino Real Palo Alto CALIFORNIA 94306

(LAST LISTED OWNER) BOX, INC. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022

ASSIGNMENT RECORDED

**Assignment  
Recorded****Attorney of  
Record** Joseph V. Myers III**Type of Mark** SERVICE MARK**Register** PRINCIPAL**Affidavit Text** SECT 8 (6-YR).**Live/Dead  
Indicator** LIVE[TESS HOME](#)[NEW USER](#)[STRUCTURED](#)[FREE FORM](#)[BROWSE DICT](#)[SEARCH OG](#)[TOP](#)[HELP](#)[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



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BOX

<b>Word Mark</b>	BOX
<b>Goods and Services</b>	IC 035. US 100 101 102. G & S: advertising the goods and services of others via the Internet. FIRST USE: 20090601. FIRST USE IN COMMERCE: 20090601
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77343975
<b>Filing Date</b>	December 4, 2007
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	August 5, 2008
<b>Change In Registration</b>	CHANGE IN REGISTRATION HAS OCCURRED
<b>Registration Number</b>	3722965
<b>Registration Date</b>	December 8, 2009
<b>Owner</b>	(REGISTRANT) Box.net, Inc. CORPORATION WASHINGTON 1895 El Camino Real Palo Alto CALIFORNIA 94306  (LAST LISTED OWNER) BOX, INC. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Joseph V. Myers III
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL



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BOX

**Word Mark** BOX

**Goods and Services** IC 041. US 100 101 107. G & S: On-line journals, namely, blogs discussing technology and business. FIRST USE: 20070101. FIRST USE IN COMMERCE: 20070101

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 77976378

**Filing Date** December 4, 2007

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** August 5, 2008

**Change In Registration** CHANGE IN REGISTRATION HAS OCCURRED

**Registration Number** 3612423

**Registration Date** April 28, 2009

**Owner** (REGISTRANT) Box.net, Inc. CORPORATION WASHINGTON 1895 El Camino Real Palo Alto CALIFORNIA 94306

(LAST LISTED OWNER) BOX, INC. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Nigamnarayan Achaya

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

Affidavit Text      SECT 8 (6-YR).

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**Word Mark** BOX**Goods and Services**

IC 009. US 021 023 026 036 038. G & S: Computer software for online management of business content in the field of cloud computing services; computer software, namely, downloadable programs and mobile device software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer software for cloud content management; computer software for providing access to, providing information to, and obtaining information from computer networks for cloud content management; computer software for synchronizing local computer files, folders, data and information with a cloud storage platform; computer software for synchronizing computer files, folders, data and information within a collaborative work environment; computer software for use in data storage and file synchronization. FIRST USE: 20111010. FIRST USE IN COMMERCE: 20111010

IC 039. US 100 105. G & S: Electronic storage of remote computer data. FIRST USE: 20111010. FIRST USE IN COMMERCE: 20111010

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design**

01.15.06 - Advertising, skywriting; Clouds; Fog

**Search Code**

26.09.21 - Squares that are completely or partially shaded

**Serial****Number**

85466608

**Filing Date**

November 7, 2011

**Current Basis** 1A**Original****Filing Basis**

1A

**Published for Opposition**

January 8, 2013

**Registration Number**

4656568

**Registration Date** December 16, 2014

**Owner** (REGISTRANT) BOX, INC. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Joseph V. Myers III

**Prior Registrations** 3348382;3429191;3612423;3722965;3921591;AND OTHERS

**Description of Mark** The color(s) blue, white and gray is/are claimed as a feature of the mark. The mark consists of the term "box" in stylized blue on a square background containing a white cloud with a bit of blue sky showing above the white cloud. The color gray appears as shadowing for the bottom edge of the square.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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## BOX SYNC

Word Mark  
Goods and  
Services

BOX SYNC

IC 009. US 021 023 026 036 038. G &amp; S: Computer software for synchronizing local computer files, folders, data and information with a cloud storage platform; computer software for synchronizing computer files, folders, data and information within a collaborative work environment; computer software for use in data storage and file synchronization. FIRST USE: 20100615. FIRST USE IN COMMERCE: 20100615

IC 042. US 100 101. G &amp; S: Computer services, namely, providing temporary use of on-line non-downloadable computer software for synchronizing local computer files, folders, data and information with a cloud storage platform; computer services, namely, providing temporary use of on-line non-downloadable computer software for synchronizing computer files, folders, data and information within a collaborative work environment. FIRST USE: 20100615. FIRST USE IN COMMERCE: 20100615

Standard  
Characters  
ClaimedMark Drawing  
Code

(4) STANDARD CHARACTER MARK

Serial Number 85450245

Filing Date October 18, 2011

Current Basis 1A

Original Filing  
Basis 1APublished for  
Opposition April 3, 2012Change In  
Registration CHANGE IN REGISTRATION HAS OCCURRED  
4160656

**Registration Number**  
**Registration Date** June 19, 2012  
**Owner** (REGISTRANT) BOX, INC. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Joseph V. Myers III  
**Prior Registrations** 3429191;3612423;3722965;AND OTHERS  
**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SYNC" APART FROM THE MARK AS SHOWN  
**Type of Mark** TRADEMARK. SERVICE MARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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# BOX NOTES

#### Word Mark Goods and Services

#### BOX NOTES

IC 009. US 021 023 026 036 038. G & S: Computer software for capturing, organizing, searching, storing, synchronizing, recognizing, sharing, editing and transmitting any number of typed or imaged notes within a collaborative work environment. FIRST USE: 20130930. FIRST USE IN COMMERCE: 20130930

IC 042. US 100 101. G & S: Computer services, namely, providing temporary use of on-line non-downloadable computer software for capturing, organizing, searching, storing, synchronizing, recognizing, sharing, editing and transmitting any number of typed or imaged notes within a collaborative work environment. FIRST USE: 20130930. FIRST USE IN COMMERCE: 20130930

#### Standard Characters Claimed

#### Mark Drawing Code

(4) STANDARD CHARACTER MARK

#### Serial Number

85979605

#### Filing Date

April 29, 2013

#### Current Basis

1A

#### Original Filing Basis

1B

#### Published for Opposition

August 27, 2013

#### Registration Number

4668273

#### Registration Date

January 6, 2015

#### Owner

(REGISTRANT) Box, Inc. CORPORATION DELAWARE 4440 El Camino Real Los Altos CALIFORNIA 94022



<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Joesph V. Myers III
<b>Prior Registrations</b>	3429191;3612423;3722965;AND OTHERS
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NOTES" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	TRADEMARK. SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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